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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,832

11/12/2003

Timothy Addington

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EXAMINER

SCHNURR, JOHN R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,832	Applicant(s) ADDINGTON ET AL.	
	Examiner JOHN R. SCHNURR	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) 1-39,54-69,73-106,117-120 and 125-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-53,70-72,107-116 and 121-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/16/2005, 07/07/2005 and 07/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-39 and 82-106, drawn to a telephone voice response based cable television provisioning system, classified in class 725, subclass 122.
 - II. Claims 40-53, 70-72, 107-116 and 121-124, drawn to a website based cable television provisioning system, classified in class 725, subclass 110.
 - III. Claims 54-59, 73-81 and 130, drawn to a database storing cable service provider records, host type data and service location data, classified in class 707, subclass 104.1.
 - IV. Claims 60-65 and 117-120, drawn to a STB based cable television provisioning system, classified in class 725, subclass 37.
 - V. Claim 66-69 and 125-129, drawn to a retail store based cable television provisioning system, classified in class 705, subclass 1.
2. Inventions I, II, III, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable.

In the instant case, subcombination I has separate utility such as a telephone based service system.

In the instant case, subcombination II has separate utility such as a web based service system.

In the instant case, subcombination IIII has separate utility such as a source of cable provider information.

In the instant case, subcombination IV has separate utility such as a STB based service system.

In the instant case, subcombination V has separate utility such as a system for selling STBs.

See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Karl Koster on 03/03/2008 a provisional election was made without traverse to prosecute the invention of Group II, claims 40-53,

70-72, 107-116 and 121-124. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-39, 54-69, 73-106, 117-120 and 125-130 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

6. This Office Action is in response to Application No. 10/712,832 filed 11/12/2003. Claims 40-53, 70-72, 107-116 and 121-124 are pending and have been examined.

7. The information disclosure statements (IDS) submitted on 06/16/2005, 07/07/2005 and 07/20/2005 were considered by the examiner.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 52 and 121 recite the limitation "the enhanced services system" in lines 1 and 15, respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims **40-53, 107-116 and 121-124** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Borelli et al. (US Patent Application Publication 2006/0020525)**, herein Borelli, in view of **Tamura (US Patent Application Publication 2003/0048380)**.

Consider **claim 40**, Borelli clearly teaches a system for provisioning a service comprising:

a computer operatively connected to a communications network; **(Fig. 2: Computer 18 can access the Internet and communicate with ISP website 20, [0037].)**

capable of displaying cable service options and receiving service related input data from a user, **(The customer is provided with offering options and requests one or more of the services, [0052]. The services include services provided by broadband content providers and broadband service providers, i.e. cable services, [0030].)** the computer capable of generating a first provisioning message with a first format including the service related input data; **(The selected offerings are communicated to the website, [0052].)**

an Internet Service Provisioning Gateway (IPSG) operatively connected to the communications network, **(Fig. 2 ISP website 20)** capable of hosting a web site providing the cable service options to the computer and receiving the first provisioning message, **(The website displays the available service options, [0048].)** the IPSG capable of generating a second provisioning message having a second format including the service related input data and a user identifier to an enhanced services system (ESS) operatively connected to the IPSG. **(The customer selects the desired services and provides contact information, [0052], this**

Art Unit: 2623

information is then forwarded to provisioning manager 48, Fig. 11 [0064].)

However, Borelli does not explicitly teach transmitting a host identifier to the enhanced services system.

In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches providing a host identifier including a conditional access module identifier when provisioning a set-top box. **(Fig. 3 Step 310 [0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by transmitting a host identifier to the enhanced services system, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 41**, Borelli combined with Tamura, as in claim 40, clearly teaches the second provisioning message further includes a host identifier. **(Fig. 3 Step 310 [0027] Tamura)**

Consider **claim 42**, Borelli combined with Tamura, as in claim 40, clearly teaches the second provisioning message further includes a conditional access module identifier. **(Fig. 3 Step 310 [0027] Tamura)**

Consider **claim 43**, Borelli combined with Tamura, as in claim 40, clearly teaches provisioning a set-top box in response to a message containing service related data and a host identifier.

Tamura further teaches selecting a host file associated with a host type. **([0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by selecting a host file associated with a host type, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 44**, Borelli combined with Tamura, as in claim 43, clearly teaches the host file contains a configuration message associated with the host type, **([0027] Tamura)** the configuration message further associated with a service identified by the service related input data. **(The provisioning manager 48 sends a provisioning message containing the selected services, [0066]-[0067] Borelli.)**

Consider **claim 45**, Borelli combined with Tamura, as in claim 40, clearly teaches the ESS is capable of generating a legacy based command to a cable headend.

(Fig. 11: The provisioning message is provided to adapters 58 which interface with the designated provider, [0067] Borelli.)

Consider **claim 46**, Borelli combined with Tamura, as in claim 40, clearly teaches the legacy based command initializes a host. **(The service provider uses the service order to provision the customer, [0067] Borelli.)**

Consider **claim 47**, Borelli combined with Tamura, as in claim 40, clearly teaches the ESS is capable of generating a third provisioning message that is received by a host on a cable network. **(The provisioning manager institutes the necessary actions at the device level, for example custom software installation, [0070] Borelli.)**

Consider **claim 48**, Borelli combined with Tamura, as in claim 40, clearly teaches the IPSP is operatively connected to a location serviceability database. **(Fig. 2: Database 28 stores information indicating locations that maybe serviced, [0041] Borelli.)**

Consider **claim 49**, Borelli combined with Tamura, as in claim 40, clearly teaches the location serviceability database receives location data associated with the user and selects at least one cable system provider based on the location data. **(The database receives customer location data and selects services available to the customer, [0041] and [0048] Borelli.)**

Consider **claim 50**, Borelli combined with Tamura, as in claim 40, clearly teaches the IPSP is capable of selecting one of a plurality of ESSs operatively connected to the IPSP, the selection determined in part on data received from the computer. **(Based on the services selected by the customer the provisioning message is transmitted to the selected providers, [0067] Borelli.)**

Consider **claim 51**, Borelli clearly teaches a system for provisioning a service comprising:

a computer operatively connected to the Internet and capable of accessing a web site; **(Fig. 2: Computer 18 can access the Internet and communicate with ISP website 20, [0037].)**

the computer capable of displaying service options and receiving service related input data from a cable subscriber; **(The customer is provided with offering options and requests one or more of the services, [0052]. The services include services provided by broadband content providers and broadband service providers, i.e. cable services, [0030].)**

an Interact Service Provisioning Gateway (IPSG) operatively connected to the Internet, capable of hosting the web site, **(Fig. 2 ISP website 20)** the web site providing cable service data to be displayed on the computer, **(The website displays the available service options, [0048].)** the IPSG receiving from the computer both service related input data and cable subscriber location data, the IPSG generating a first provisioning message having a first format including the cable subscriber location data; **(The database 28 receives customer location data and selects services available to the customer, [0041] and [0048].)**

a serviceability database operatively connected to the IPSG to receive the first provisioning message, the serviceability database containing a plurality of cable service provider location data and a plurality of cable service provider identifiers **(Fig. 2: Database 28 stores information indicating locations that maybe serviced, [0041].)**, the serviceability database capable of receiving the cable subscriber location data and selecting a cable service provider identifier, the serviceability database further capable of generating a second provisioning message including at least one cable service provider identifier. **(The database receives customer location data and selects services available to the customer, [0041] and [0048].)**

However, Borelli does not explicitly teach transmitting a host identifier.

In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches providing a host identifier including a conditional access module identifier when provisioning a set-top box. **(Fig. 3 Step 310 [0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by transmitting a host identifier to the enhanced services system, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Consider **claim 52**, Borelli combined with Tamura, as in claim 50, clearly teaches the enhanced services system is operatively connected to the IPSG and receives a third provisioning message containing the service related input data, **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064] Borelli.)** the ESS further receiving a subscriber identifier **(Workflow manager 50 provisions a service for a specific customer, [0066] Borelli.)** and selecting a host file based in part on the host type identifier and the service related input data, **([0027] Tamura)** the ESS generating a configuration message to a host, wherein the configuration message is derived from the host file. **(The**

provisioning manager institutes the necessary actions at the device level, for example custom software installation, [0070] Borelli.)

Consider **claim 53**, Borelli combined with Tamura, as in claim 50, clearly teaches the ESS further authenticates the third provisioning message received from the IPSG prior to generating the configuration message. **([0061] Borelli)**

Consider **claim 107**, Borelli clearly teaches a method of provisioning a cable service comprising:

receiving cable subscriber identification data as input data from a computer at a web site; **([0037])**

receiving service related data from the computer at the web site; **([0048])**

generating a first provisioning message with a first format at a second computer hosting the web site, the first provisioning message containing the cable subscriber identification data and the service related data; **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064].)**

receiving the first provisioning message at an enhanced services system; **(The desired services are provided to the provisioning manager 48, Fig. 11 [0064].)**

selecting a host file in the enhanced services system based on the service related data;
generating a host-specific configuration message based on a host protocol file; and
sending the host-specific configuration message to a host associated with the cable subscriber. **([0070])**

However, Borelli does not explicitly teach transmitting a host identifier to the enhanced services system.

In an analogous art, Tamura, which discloses a system for provisioning a set-top box, clearly teaches providing a host identifier including a conditional access module identifier when provisioning a set-top box. **(Fig. 3 Step 310 [0027])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli by transmitting a host identifier to the enhanced services system, as taught by Tamura, for the benefit of providing system specific provisioning of the set-top box (see [0004] Tamura).

Art Unit: 2623

Consider **claim 108**, see claim 107.

Consider **claim 109**, see claim 50.

Consider **claim 110**, see claim 42.

Consider **claim 112**, Borelli combined with Tamura, as in claim 107, clearly teaches the cable service data pertains to high speed Internet access. **([0030] Borelli)**

Consider **claim 111**, Borelli combined with Tamura, as in claim 107, clearly teaches the cable service data pertains to a digital video program offered on a cable network. **(The services include services provided by broadband content providers and broadband service providers, i.e. cable services, [0030] Borelli.)**

Consider **claim 113**, see claim 107.

Consider **claim 114**, see claim 107.

Consider **claim 115**, Borelli combined with Tamura, as in claim 114, clearly teaches the one provisioning message is received at an ESS associated with the service provider. **([0064] Borelli)**

Consider **claim 116**, Borelli combined with Tamura, as in claim 114, clearly teaches the one provisioning message is received at a billing system associated with the service provider. **([0063] Borelli)**

Consider **claim 121**, see claim 40.

Consider **claim 122**, Borelli combined with Tamura, as in claim 121, clearly teaches the host type is determined in part using the user identifier. **(Identifying information includes device type, [0027] Tamura.)**

Consider **claim 123**, Borelli combined with Tamura, as in claim 121, clearly teaches the host type is determined by a parameter contained in the second message. **(Host type is sent to the provisioning system, [0027] Tamura.)**

Consider **claim 124**, Borelli combined with Tamura, as in claim 121, clearly teaches the IPSP determines the enhanced services system based on the cable network provider. **([0064] Borelli)**

12. Claims **70-72** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Borelli et al. (US Patent Application Publication 2006/0020525) in view of **Tamura**

(US Patent Application Publication 2003/0048380), as applied to claims 40, 51, 107, 108, 113, 114 and 121 above, and further in view of **Grzeczowski (US Patent 6,687,486)**.

Consider **claim 70**, Borelli combined with Tamura, as in claims 40, 51, 107, 108, 113, 114 and 121, clearly teaches a provisioning system containing the limitations shared by claim 70 and the above claims. Borelli combined with Tamura further inherently includes a database storing inventory and feature data associated with the host type in order to provide the provisioning message for the specific host type. **([0027] Tamura)**

However, Borelli combined with Tamura does not explicitly teach displaying the feature data to the user.

In an analogous art, Grzeczowski, which discloses a system for provisioning a STB, clearly teaches displaying the feature data to the user. **(column 5 lines 49-57)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Borelli combined with Tamura by displaying the feature data to the user, as taught by Grzeczowski, for the benefit of enabling to user to identify supported features of the STB.

Consider **claim 71**, see claim 51.

Consider **claim 72**, see claim 51.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Schnurr whose telephone number is (571) 270-1458. The examiner can normally be reached on Monday - Friday, 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRS

/Christopher Grant/

Supervisory Patent Examiner, Art Unit 2623